

1 REMARKS

2 Status of the Claims

3 Claims 1 - 8 and 10 - 33 remain pending in the present application. Claims 1, 12, 18, and 24  
4 have been amended to more clearly define the present invention and better distinguish over the prior  
5 art cited by the Examiner in the Final Office Action mailed prior to applicant's filing the RCE  
6 submitted concurrently herewith.

7 Comments Regarding Patentability of Independent Claims

8 In the Final Office Action, the Examiner rejected independent Claims 1 and 24 under 35  
9 USC § 103(a) as being obvious in view of Corel WordPerfect 6.1, 1996, in view of "Twain White  
10 Paper," (<http://www.twain.org>) 1996, pages 1-4, (herein referred to as "the Twain reference"). While  
11 applicants respectfully disagree with the Examiner and the manner in which the references are  
12 construed as disclosing all of the steps or elements of the claimed invention, the amendment to the  
13 independent claims set forth above in this Preliminary Amendment should serve as a further basis for  
14 convincing the Examiner to withdraw the rejection of all claims remaining in the application.

15 Although the Examiner also rejected all of the dependent claims over various combinations of  
16 cited art, to simplify this Preliminary Amendment, to simplify these comments, applicants will only  
17 discuss the three independent claims in the application in regard to the prior rejection, and dependent  
18 Claim 12. Applicants' decision not to comment on the rejection of the other dependent claims should  
19 not be construed as an admission that applicants agree with the Examiner's rejection of these claims  
20 or with the conclusions or comments of the Examiner in justifying his rejection of the claims.  
21 Applicants believe that the dependent claims are also patentable over the art of record.

22 Each of the independent claims in the application has been amended to recite using a special  
23 application programming interface (API) module accessed from within the application program. As  
24 recited in Claim 1, for example, this special API module interfaces the application program with a  
25 TWAIN module that is used for acquiring an image with the image source device that is active. In  
26 addition, the special API module provides a user interface that is presented to a user within and under  
27 control of the application program. Thus, the special API module isolates a user from directly  
28 interacting with the TWAIN module and thereby simplifies the step of acquiring the image. Support  
29 for this amendment is provided in applicants' specification under the section entitled, "OFFICE 2000  
30 TWAIN Implementation," starting on page 37. At line 25, this special module, which is identified in

1 the description of a preferred embodiment as the MSOTW9.DLL API module, is disclosed as  
2 comprising "a single entry point" for implementing various features of TWAIN. The functions  
3 provided by this special API module are discussed in the rest of this section and fully support the  
4 amendments to the independent claims.

5 In contrast to applicants' invention as now claimed, the prior art fails to teach or suggest use  
6 of a special API module having the functionality of that recited in applicants independent claims.  
7 One of the problems with the Examiner's rejection of applicants claims even before the current  
8 amendment is that there is no teaching or suggestion of how the alleged direct scanning of an image  
9 into a WordPerfect document is carried out or any teaching or suggestion that would lead one of  
10 ordinary skill in the art to understand that it was done without directly interfacing the application with  
11 the TWAIN API modules. Applicants have explained at length how the prior art approach for  
12 scanning images is implemented and have contrasted this conventional approach with the novel  
13 technique that is used in their invention. To simply the acquisition of images from within a software  
14 application, applicants created this special API module to serve as an interface between the software  
15 application and the TWAIN API modules that actually interact with an active image scanning device  
16 to scan an image.

17 None of the cited art mention use of a special API module like that recited in applicants'  
18 claims. Further, there is no disclosure or suggestion of how the functionality provided by this module  
19 can be achieved in WordPerfect. Clearly, many of the functions achieved by applicants' special API  
20 module are not included in WordPerfect, and the Examiner has relied upon an assertion that it would  
21 be obvious to combine various other references with WordPerfect to provide these functions.  
22 However, it is not clear how such a combination would be achieved, since there is no enabling  
23 disclosure in any of these references that would lead one of ordinary skill in the art to modify  
24 WordPerfect to include such functionality. For example, in regard to Claim 12, the Examiner  
25 previously rejected the claim based on the combination of WordPerfect, Twain, and Ulead  
26 PhotoImpact 3.0, indicating the PhotoImpact reference discloses displaying an error message if a  
27 selected device is not a TWAIN device and asserting that it would have been obvious to determine  
28 "from within the application program whether the image source device that is active is able to  
29 perform an automatic image scan." However, this logic is respectfully flawed, because the  
30 applicants' claim does NOT recite that there is a determination of whether the image source that is

1 active is a TWAIN device. Instead, the special API module determines "whether the image source  
2 device that is active is able to perform an *automatic* image scan" (emphasis added). If not, the active  
3 image source device, which can still be a TWAIN device even if not able to do an automatic scan,  
4 can be used in a more conventional manner to scan an image. Further, it is not clear how one of  
5 ordinary skill in the art would know how to modify the WordPerfect program to make such a  
6 determination, since there is no enabling disclosure regarding such a modification in any of the art  
7 cited. These same kinds of issues exist in the arguments asserted by the Examiner to reject many of  
8 the other dependent claims. Accordingly, Claim 12 and all other dependent claims are patentable  
9 over the art of record, at least for the same reasons as the independent claims from which they  
10 depend.

11 Based upon the comments made above, it should be evident that all claims in the present  
12 application are patentable. Accordingly, the application should be passed to issue without further  
13 delay. If any issues remain, the Examiner is invited to telephone applicants' attorney at the number  
14 listed below.

15 Respectfully submitted,

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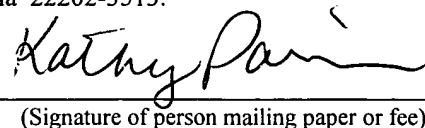
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